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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,914	11/27/2001	Satoru Okada	723-1222	7392

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EXAMINER

PHAM, TUAN

ART UNIT PAPER NUMBER

2643

DATE MAILED: 07/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/994,914

Applicant(s)

OKADA ET AL.

Examiner

TUAN A. PHAM

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply.

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 15, 16 and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 15-16, and 21-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6-22-05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 06/22/2005 has been considered by Examiner and made of record in the application file.

Response to Arguments

2. Applicant's arguments with respect to claims 1-6, 15-16, and 21-26 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1- 5, 15-16, and 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagasawa (U.S. Patent No.: 6,782,281) in view of Nishiyama (Pub. No.: US 2003/0060287).

Regarding claim 1, Nagasawa teaches an electronic apparatus, comprising (see figure 1B):

a game CPU which executes a game related process (see figure 6, controller for pocket game 28, col.5, ln.15-22),

a phone CPU which executes a phone related process (see figure 6, controller 22, col.5, ln.15-22),

the game related process includes the game process to play the game and an interruption process to interrupt the game process when a setting of the first register indicates the first predetermined value (see figure 6, controller for pocket game 28, col.5, ln.15-30), and

the phone related process includes a setting process to set the first predetermined value into the first register (read on controller) when an incoming phone call is detected (see figure 6, controller 22, col.5, ln.23-30, col.6, ln.13-20, the controller 22 is detected the incoming call).

It should be noticed that Nagasawa fails to teach an interruption key to initiate an interruption of a game, and a first register to which a first predetermined value is set in response to an operation of said interruption key. However, Nishiyama teaches such

features (see figure 14, pause key 783c, [0159], the pause key is inherently preassigned with a predetermined value).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Nishiyama into view of Nagasawa in order to provide a multi function for electronic device with detecting the incoming call while the user is playing game on the device as suggested by Nagasawa at col.2, ln. 1-16.

Regarding claim 2, Nagasawa further teaches the electronic apparatus, wherein the game related process further includes a storing process to store current game data into a memory when the setting of the first register indicates the first predetermined value (see figure 6, controller pocket game 28, col.5, ln.15-22, the pause key is inherently preassigned with a predetermined value).

Regarding claim 3, Nagasawa further teaches the electronic apparatus wherein the phone related process further includes a determination process to determine whether the game process is in an activated state or not, and the setting process sets the first predetermined value into the first register response to a detection of the incoming phone call when a determination result of the determination process is affirmative (see figure 6, controller 22, col.5, ln.15-30).

Regarding claim 4, Nagasawa further teaches the electronic apparatus further comprising: a restart key to initiate a resumption of the game process; a second register to which a second predetermined value is set in response to operation of the restart key; and wherein the game related process further included restart process to resume

the game process when setting of the second register indicates the second predetermined value (see figure 9, key 5B, restart the game S34, col.6, ln.21-27, the restart key is inherently preassigned with a predetermined value).

Regarding claim 5, Nagasawa further teaches the electronic apparatus further comprising: a display which displays a game screen, wherein the phone related process further includes a modifying process to modify a tone of the game screen in response to a detection of the incoming phone call (see figure 6, first display 4, speaker 23, col.5, ln.3-50).

Regarding claim 15, Nishiyama further teaches the electronic apparatus wherein the interruption continues to pause the game process (see [0159]).

Regarding claim 16, Nagasawa further teaches the electronic apparatus wherein the restart process removes the first predetermined value from the first register and removes the second predetermined value from the second register (see col.6, ln.21-28, the restart key is inherently preassigned with a predetermined value).

Regarding claim 21, Nagasawa teaches an electronic apparatus for enabling a user to play a videogame or communicate in a telephone call, the electronic apparatus comprising (see figure 1B):

a user-operable key (see figure 2B, key pad 10),

a detector which detects receipt of an incoming telephone call (see figure 6, controller 22, col.5, ln.23-30, col.6, ln.13-20, the controller 22 is detected the incoming call), and

suspend the play of video game as a result of the detector detecting receipt of an incoming telephone call (see figure 6, controller 22, col.5, ln.13-30).

It should be noticed that Nagasawa fails to teach a pausing mechanism which pauses play of a videogame by the electronic apparatus as a result of operation of the user-operable key. However, Nishiyama teaches such features (see figure 14, pause key 783c, [0159]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Nishiyama into view of Nagasawa in order to provide a multi function for electronic device with detecting the incoming call while the user is playing game on the device as suggested by Nagasawa at col.2, ln.1-16.

Regarding claim 22, Nagasawa further teaches a pause mechanism features and a pauses play of the videogame as a result of the detector detecting receipt of the incoming telephone call, the pausing mechanism pauses play without requiring operation of the user-operable key (see col.5, ln.15-30, col.6, ln.1-27, the controller 22 is detected the incoming call).

Regarding claim 23, Nagasawa further teaches an electronic apparatus, wherein videogame play is resumed after the pausing mechanism pauses play of the videogame as a result of operation of the user-operable key (see col.6, ln.21-28).

Regarding claim 24, Nagasawa teaches an electronic apparatus for enabling a user to play a videogame or communicate in a telephone call, the electronic apparatus comprising (see figure 1B):

a user-operable key (see figure 2B, key pad 10),
a detector which detects receipt of an incoming telephone call (see figure 6, controller 22, col.5, ln.23-30, col.6, ln.13-20, the controller 22 is detected the incoming call), and

setting the predetermined value in the register upon the detector detecting receipt of an incoming telephone call (see figure 6, controller 22, col.5, ln.23-30, col.6, ln.13-20, it is inherently that the controller 22 is pre-programmed a value for detecting the incoming call).

It should be noticed that Nagasawa fails to teach a setting mechanism for setting a predetermined value in a register upon operation of the user-operable key, and an interrupting mechanism which interrupts game play of a videogame by the electronic apparatus when the predetermined value is set in the register. However, Nishiyama teaches such features (see figure 14, pause key 783c, [0159], the pause key is inherently preassigned with a predetermined value).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Nishiyama into view of Nagasawa in order to provide a multi function for electronic device with detecting the incoming call while the user is playing game on the device as suggested by Nagasawa at col.2, ln.1-16.

Regarding claim 25, Nagasawa further teaches an electronic apparatus, wherein when setting mechanism sets the predetermined valued in the register upon the detector detecting receipt of the incoming call, the interrupting mechanism interrupts

the play of the videogame without requiring operation of the user-operable key (see col.5, ln.15-30, col.6, ln.1-27, the controller 22 is detected the incoming call).

Regarding claim 26, Nagasawa further teaches videogame play is resumed after the interrupting mechanism interrupts play of the videogame upon operation of the user-operable key (see col.6, ln.21-28).

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nagasawa (U.S. Patent No.: 6,782,281) in view of Nishiyama (Pub. No.: US 2003/0060287) as applied to claim 1 above, and further in view of Simon et al. (Pub. No.: US 2003/0087652, hereinafter, Simon”).

Regarding claim 6, Nagasawa and Nishiyama, in combination, fails to teach the electronic apparatus further comprising: wherein the game related process is executed according to a game program downloaded from an outside source. However, Simon teaches such features (see [0005]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Simon into view of Nagasawa and Nishiyama in order to download the data in wireless fashion.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Tuan A. Pham** whose telephone number is (571) 272-8097. The examiner can normally be reached on Monday through Friday, 8:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz can be reached on (571) 272-8097 and

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July 14, 2005

Examiner

Tuan Pham


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